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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/767,546	01/23/2001	Pradeep K. Subrahmanyam	S01.12-0644	3008

7590 12/16/2003

Westman Champlin & Kelly  
900 Second Avenue South  
Suite 1600 International Centre  
Minneapolis, MN 55402-3319

EXAMINER
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SNIEZEK, ANDREW L

ART UNIT	PAPER NUMBER
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2651

DATE MAILED: 12/16/2003

15

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/767,546

Applicant(s)

SUBRAHMANYAN

Examiner

Andrew L. Snizek

Art Unit

2651

— The MAILING DATE of this communication appears on the cover sheet with the correspondence address —  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 12 September 2003.
- 2a) ☒ This action is FINAL. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 19-36 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 19-34 and 36 is/are rejected.
- 7) ☒ Claim(s) 35 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_ 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

The following action is taken after consideration of the appeal brief filed 9/12/03.

The finality of the previous office action is withdrawn in view of the new grounds of rejection presented below.

***Claim Rejections - 35 USC § 102***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 19, 20, 28, 31-34 are rejected under 35 U.S.C. 102(e) as being anticipated by Baba ('162).

The body of this rejection is incorporated herein from paragraph 3 of the office action mailed 4/16/03.

***Claim Rejections - 35 USC § 103***

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Claims 21-24, 26, 27, 29, 30 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Baba in view of Clare et al. ('286).

The body of this rejection is incorporated herein from paragraph 5 of the previous office action mailed 4/16/03.

Claim 25 is rejected under 35 U.S.C. 103(a) as being unpatentable over Baba in view of Clare et al. ('286) as applied to claims 21-24, 26 and 36 above, and further in view of official notice.

The body of this rejection is incorporated herein from paragraph 6 of the previous office action mailed 4/16/03.

***Claim Rejections - 35 USC § 112***

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 19 and 28 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for specific arrangements such as those group of elements as depicted for example in figure 2, does not reasonably provide enablement for every conceivable structure for achieving the stated result of adaptively generating an output as set forth by the claims. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. See *In re Hyatt*, 708 F.2d 712, 714-715, 218 USPQ 195, 197 (Fed. Cir. 1983).

***Allowable Subject Matter***

Claim 35 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

The following is a statement of reasons for the indication of allowable subject matter:

The reasons for the indication of allowable subject matter of claim 35 were presented in paragraph 8 of the office action mailed 4/16/03.

***Response to Arguments***

Applicant's arguments filed 9/12/03 have been fully considered but they are not persuasive. Examiner acknowledges the definitions provided by applicant, however these definitions are not a one-to-one correspondence with the claimed language. The claims set forth an apparatus for adaptively generating. By definition an "adaptive system" is a "system that is capable of altering its behavior based on certain features of its experience or environment", Microsoft Press Computer Dictionary, (Third Edition, 1997, Microsoft Corporation). Clearly Baba teaches a system that alters its behavior based on features of its experience or environment. Even by applicants own definition the system of Baba provides an arrangement that automatically changes the influence of initial parameters that improve the performance of the system. The discrete controller as claimed is deemed satisfied by Clare et al. for reasons already provided. Applicants arguments concerning claim 25, pulse width modulation (PWM) is acknowledged however Phan et al. ('345) already cited by applicant teaches that a PWM technique used in an ADAPTIVE CONTROL PROCEDURE is well known to control the actuator.

### ***Conclusion***

Applicant's amendment filed 2/19/03 necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after

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Art Unit: 2651

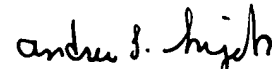
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the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Andrew L. Sniezek whose telephone number is 703-308-1602. The examiner can normally be reached on Mon.-Fri..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Hudspeth can be reached on 703-308-4825. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9314 for regular communications and 703-872-9314 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-4700.

  
Andrew L. Sniezek  
Primary Examiner  
Art Unit 2651

A.L.S.  
December 14, 2003